

## **II) REMARKS**

The following remarks are presented in response to the Office action dated May 4, 2006. The Applicant thanks the Examiner for the courtesy of the telephonic interview conducted on May 23, 2006. No agreement was reached during the interview. The Examiner requested the Applicant to present the comments made during the interview in this written response.

After explaining the Applicant's position as stated below with respect to the patentability of the claims based at least on the cited prior art lacking the claimed ***“means for storing a plurality of user profile data records, each of said user profile data records comprising user profile data comprising: an identification of a user, and at least one geographic location associated with the user”***, or a ***“means . . . for analyzing a coupon offer with respect to a plurality of user profile data records, and for generating one or more coupons based on said analysis”***, it was represented to the Applicant that additional prior art would likely be cited in a subsequent Office action on this issue. While Applicant is desirous of addressing all relevant prior art in order to establish the patentability of its invention, Applicant wishes to point out that “piecemeal examination should be avoided as much as possible” (MPEP 707.07(g)). The examiner should reject each claim on all valid grounds available. Id. Applicant therefore respectfully requests the Patent Office to make all possible rejections of the present claims, if any can be made, in any subsequent Office action (which should not be final since there are no claim amendments herein) in order to expedite prosecution.

Claims 41-44, 47, 49, 50, 52-60, 62, 64-72, 75, 77, 78, 80-88, 90, and 92-96 have been rejected under 35 USC 102(b) as allegedly being anticipated by Tagawa (USP 5,732,398). Claims 51 and 79 are rejected under 35 USC 103(a) as being unpatentable over Tagawa. Claims 61, 63 and 89 are rejected under 35 USC 103(a) as being unpatentable over Tagawa in view of Barnett (USP 6,321,208). Applicant respectfully traverses these rejections since Tagawa clearly does not teach or render obvious the limitations set forth in the rejected claims.

By way of review, the Applicant's invention provides a system that allows coupon providers to generate packages of one or more offers or coupons to users. A plurality of user profile records are generated, each of which includes a geographic location associated with a user, which may be, for example, a destination to which the user will travel. The user profile record may also include his or her travel preferences, purpose of travel, and the time frame for travel (which may be entered by the user or acquired from various preexisting databases). The system analyzes this profile information in an intelligent and proactive manner and then generates a personalized collection of one or more purchase incentive coupons where the offer is valid for that user and only at the geographic location(s) associated with the user, for the time frame specified by the user, as set forth in the user's profile. In addition to matching coupon offers to a certain user profile data record (i.e. finding relevant offers for a given user), the system will match user profile records to a certain coupon offer (*i.e. find relevant users for a given coupon offer*).

The present invention optionally provides for a registration process, wherein the user may enter his leisure and business related interests into a user profile. The user may also indicate the planned itinerary of the trip, including the dates of travel, destination, and mode of travel (this may also be obtained from preexisting databases). After registration, the system utilizes an intelligent manner of retrieving offers (i.e. coupons) from its memory that correlate to various factors in the user profile. Thus, offers would be extracted from memory that provide discounts at stores at the location of travel, and only for the duration of time that the traveler will be staying at that location. The system will also utilize its intelligence and predictive analysis to match the offers to the previously stored traveler profile; for example, a business traveler might be provided with coupons for use at a business center (e.g. copy store), while a leisure traveler might only get coupons for use at a theme park at that location. Optionally, the terms of the coupon offers may be modified by the issuer directly with the coupon server prior to distribution of the coupons.

Thus, claim 41 recites a coupon generation and distribution system that has a centrally located coupon server computer and a plurality of member computers interconnected to a

computer network. Each of the member computers is associated with a member of the system (members may include a user/traveler, a travel agent, a coupon offering entity, an airline, cruise line, restaurant, retail shop, manufacturer, duty-free shop, etc.). The coupon offering entities supply coupon offers (which provide an incentive to purchase an item) to the centrally located coupon server computer, which then assembles the coupon offers into a repository of coupon offers available for generation into coupons for dissemination to the users. The coupon server computer has *means for storing a plurality of user profile data records*, each having user profile data including an identification of a user and at least one geographic location (e.g. a destination) associated with that user. The coupon server also has means for analyzing a given user profile data record with respect to all of the coupon offers in the repository (and/or *analyzing a given coupon offer with respect to a plurality of the user profile data records*) and for generating one or more coupons from the coupon offers based on the analysis, wherein the coupons are limited to use by the user for items at the geographic location associated with the user (e.g. his or her travel destination). The coupon server computer also has means for distributing the generated coupon(s) for use by the user in purchasing the item.

Independent claims 41 (and corresponding method claim 69) have been presented to clearly specify that coupons may be generated by analyzing one user profile record against the repository of offers (such as when a given user is traveling on vacation to Orlando, Florida and is given coupons for all of the entertainment venues in Orlando at the time of his travel there), or by *analyzing one offer against a plurality of the user profile records* (such as when an issuer requests the server to push a certain coupon to everyone going to New York City for business in April 2004). This is clearly supported throughout the specification, for example at page 5, lines 6-9; page 6, lines 4-9; page 14, lines 26-29; and page 25, lines 8-10. Thus no new matter has been added.

This intelligent coupon generation and distribution system and method is neither taught nor suggested by the cited Tagawa reference. Tagawa teaches a self-service kiosk that enables a person to review various travel-related services and then make a purchase *in real time* of a desired service. The kiosk prints out a “value voucher”, which is essentially a receipt showing some details of the purchased service and proof of payment

*in advance*. As indicated in the Tagawa Abstract, his invention is a “self-service system of selling travel-related services or products”. In Tagawa, the user is first queried as to travel knowledge, and enters certain information such as family orientation, age, airlines preference, lodging preference, price range, etc. Then, “one or more recommendations or a whole listing will be presented for selection by the user.” In addition, “the inventory database is searched so that only available choices will be presented.”

As explained in further detail in Tagawa, the kiosk will play a video loop to attract the attention of a potential customer who may wish to purchase travel-related services (col. 10, lines 48-51). Options are displayed to the user such as local attractions, local lodging, rental cars, tour packages, airline tickets, etc. (col. 10, lines 60-64). The user then makes a selection at the kiosk of interest, and the user is queried to see if it is his first trip to the area. The user then selects a category group on the touch screen, and can make further selections whereby various options are displayed to him based on information he has input at that time. The user can select the appropriate date from an onscreen calendar, accept the offer, and then make payment by swiping his credit card. He then receives a voucher indicating the paid for service, which has been printed on the printer of the kiosk. (see col. 11, line 1 through col. 12, line 10.)

Then, the user can select another option or service and go through the same process to select other items of interest as outlined above. At any time, when the user is finished, he simply chooses to cease interaction with the system and walks away.

A) Claims 41 and 69 are patentable because Tagawa does not teach at least the claimed “means for storing a plurality of user profile data records, each of said user profile data records comprising user profile data comprising: an identification of a user, and at least one geographic location associated with the user”, or the claimed “means . . . for analyzing a coupon offer with respect to a plurality of user profile data records, and for generating one or more coupons based on said analysis”.

Notably, this system of Tagawa does not have any type of database, storage or the like *for storing a plurality of user profile data records* as set forth in the claims. A customer that is using the kiosk at any given time will enter data such as his name and preferences, but this information is used at that time only to provide offers to the customer, and is

never stored in a database or any type of structure for subsequent analysis as in the present invention. The very nature of the Tagawa system is a self-service kiosk that someone may walk up to, purchase tickets, have those purchase tickets dispensed, and then walks away from ***with no further interaction.*** Because of the nature of this kiosk – real time ticket purchase in lieu of a travel agent – there simply is no need for ***storing a plurality of user profiles*** as in the present claims.

The use of the ***plurality of user profiles*** is set forth in the following feature of claim 41:

(iii) ***means*** for analyzing a user profile data record with respect to a plurality of coupon offers in the repository and ***for analyzing a coupon offer with respect to a plurality of user profile data records, and for generating one or more coupons based on said analysis,*** wherein said coupon is limited to use by the user identified in the user profile data record for items at the geographic location associated with the user

Pending claim 41 (emphasis added). That is, as previously explained, the present invention uses the ***stored user profiles*** to perform an analysis with respect to one particular coupon offer. The Examiner has not cited any part of Tagawa that teaches ***means for storing a plurality of user profile data records, each of said user profile data records comprising user profile data comprising: an identification of a user, and at least one geographic location associated with the user***". The Examiner has cited only the passages at col. 2, lines 50-60 and col. 5, lines 37-42 from Tagawa as anticipating this claim element:

When serving such a knowledgeable visitor, the self-service system preferably functions differently compared to serving a user who is a first-time visitor and who is not familiar with the destinations. The personal attribute of the user would include any information which can affect the user's choice of one type of travel-related service or product over another, and may include age, lifestyle (for example, fun/action seeking, family, average or quiet lifestyle), income level, and other preferences as described in detail below. If the user is traveling with one or more companions, there may be group attributes as well.

Tagawa, col. 2, lines 50-60. The only thing that may be remotely relevant is the reference to a "personal attribute" and "other preferences", but reading this passage in the context of the entire Tagawa patent leads only to the conclusion that these pieces of data are used only in real time as the user operates the kiosk, and there is no teaching that this

information is stored as a user profile *along with a plurality of other user profiles* as in the claimed invention. Also relied on by the Examiner is the following:

An additional aspect of the invention is directed towards a self-service method of selling tours outside of a local area by means of an interactive electronic travel service system functioning like a travel agent, comprising the steps of initiating two-way communication between a user and the system, asking the user to select a destination, requesting the user to select a pricing category from a number of pricing categories for tours to the destination selected by the user and displaying information on tour packages to said destination outside of a local area.

Tagawa, col. 5, lines 37-42. Although this mentions that the user selects a destination, but there is no teaching of a *means for storing a plurality of user profile data records, each of said user profile data records comprising user profile data comprising: an identification of a user, and at least one geographic location associated with the user.*

In addition, Tagawa does not teach the claimed limitation of “*means . . . for analyzing a coupon offer with respect to a plurality of user profile data records, and for generating one or more coupons based on said analysis*”, as set forth in claim 41. Since Tagawa does not have store a plurality of user profile data records, Tagawa of course cannot perform the claimed analysis. The Examiner here relies on the following passage from Tagawa in attempting to show the claimed “*means . . . for analyzing a coupon offer with respect to a plurality of user profile data records, and for generating one or more coupons based on said analysis*”:

The method comprises initiating two-way communication between a user and a system, querying the user as to whether the user has travel knowledge of said destination area, providing to the user who is a first-time visitor and who is not otherwise familiar with the destination area information concerning attractions usually preferred by first-time visitors. The method further comprises supplying choices of different local visitor attractions for selection to the user and closing a sale and confirming a reservation for the selected local visitor attraction or attractions made by the user.

Tagawa, col. 4, lines 35-45. Although this speaks of the Tagawa system feature of “supplying choices of different local visitor attractions for selection to the user”, this is relevant to a single user only, and it clearly has no relevance to the claimed limitation of

***“means . . . for analyzing a coupon offer with respect to a plurality of user profile data records, and for generating one or more coupons based on said analysis”***

The Examiner also relies on the following passage from Tagawa:

The advantage of issuing value vouchers is that like airline tickets, customers will have something to hold in their hands. All pertinent flight information will be on the voucher, not merely a confirmation number. It provides a paper trail that will be useful in processing changes, refunds or settling disputes. Like automated teller machines (ATMs), the kiosks will be located in convenient locations to solve the ticket delivery problem.

Returning to block 464 in FIG. 8B, if the user accepts the confirmation, (unless the flight has already been reserved and paid for before the user uses the kiosk as in the example above), he or she is asked to input a name or names for the flights and swipe a credit card. A value voucher is then printed and dispensed, and a "thank you" screen displayed. See blocks 464-472. The system then returns to the welcome video 204 in FIG. 3. After making the selection in block 462, if no flights are available the system will automatically connect the user to a travel agent. Preferably, only one segment flight are sold through the system.

In reference to FIG. 3, if the user selects an out-of-state tour package option 220, CPU 78 would activate the routine in FIGS. 9A, 9B. Following the audio visual introduction to out-of-state tour packages (block 500), a series of menus will appear for the user to select a destination area (blocks 502, 504). The first menu will be very broad to include foreign destinations. Subsequent menus will be more detailed to narrow the search. If the user is interested in an exotic destination or a special interest tour, the user can touch the HELP button for a travel agent. In the preferred embodiment, the kiosk is designed to process high volume, simple tour packages to destinations such as Las Vegas, California, Hawaii and Florida. If the user is interested in packages with complicated itineraries such as a fourteen-day European vacation, the user is requested to press the HELP button in order to talk to a travel agent.

After the user selects a destination, the destination area selected may be further refined. For example, if the desired destination is Las Vegas, the system will query the user to make a decision on three possible destination areas: along the Las Vegas Strip, downtown Las Vegas, or properties off the Strip. The user may also be asked to select a budget, mid-range or deluxe package (block 506). This will be followed by a qualifying phase (block 508) where the user will be queried as to travel knowledge and attribute (individual and/or group) in a manner described above to reduce the search of the database and to simplify the decision process for the user.

Tagawa, col. 16, lines 20-67. The Applicant is unable to determine how anything in this part of the Tagawa specification bears any relevance to the claimed limitation.

A detailed review of the drawings of Tagawa shows no such “*means for storing a plurality of user profile data records, each of said user profile data records comprising user profile data comprising: an identification of a user, and at least one geographic location associated with the user*”, or a “*means . . . for analyzing a coupon offer with respect to a plurality of user profile data records, and for generating one or more coupons based on said analysis*” as set forth in claim 41. Figure 2b of Tagawa is a detailed block diagram of the kiosk of his invention; nowhere is there any type of database or other means for storing *a plurality of user profile data records*, as presently claimed. A hard drive 74 is illustrated in Figure 2b, but is explained in the specification only as:

The hard drive 74 will be used to store video and audio information [to be presented to the user] that require frequent updates (col. 9, lines 45-47).

The video and audio files in the kiosk hard drive 74 will be updated from the regional reservation center to reflect current prices and current product information. (col. 9, line 67 through col. 10, line 3).

Given the input data from the user in response to these qualifying questions, the system would *search the database residing in the kiosk hard drive 74* or CD-ROM 72 in FIG. 2B. The database will be frequently updated to include the latest marketing specials (col. 17, line 65 through col. 18, line 3 (emphasis added)).

The passage directly above refers to a database of *travel offers* stored on the hard drive 74, not to a *plurality of user profile data records* as claimed. In addition:

Information on tours and activities during ports of call will be stored in the kiosk's hard drive 74 and/or CD-ROM 72 (col. 19, lines 41 – 43).

In addition, this last passage refers to *travel offers* stored on the hard drive 74, not to a *plurality of user profile data records* as claimed.

Also, there is disclosed in Tagawa an “accounting system 114” in Figure 2c (the regional reservation center in communications with the kiosk), but this is “an accounting system



114 for keeping track of the purchases made by user of kiosk in communication with center 100”. (col. 10 lines 22 – 24); i.e. it stores purchases that have been made for accounting purposes but does not store ***a plurality of user profile data records, each of said user profile data records comprising user profile data comprising: an identification of a user, and at least one geographic location associated with the user.***

Furthermore, nowhere in Tagawa is there disclosed any ability to ***analyze a coupon offer with respect to a plurality of user profile data records, and generating one or more coupons based on said analysis.*** Tagawa describes a walk-up kiosk that takes the place of a travel agent to find certain offers for those walk-up users and sell the service to that user at that time, and does not have any functionality based on storing a plurality of user profile data records and then analyzing a coupon offer with respect to a plurality of user profile data records to generate one or more coupons based on the analysis as presently claimed. Tagawa provides a self-service kiosk that is intended to attract customers, present certain offers to those customers based on customer travel information entered in real-time, sell services to those customers, and end the process with respect to that customer. Once the customer leaves the kiosk, no further interaction takes place with that customer, the kiosk goes back into a customer-attraction mode.

In order for a rejection to be properly made under 35 USC 102(b), it must be shown by the Examiner that ***each and every claim limitation*** is taught in a single reference. In re Spada, 911 F.2d 705 (Fed. Cir. 1990). Since the cited Tagawa reference does not teach the use of at least a ***“means for storing a plurality of user profile data records, each of said user profile data records comprising user profile data comprising: an identification of a user, and at least one geographic location associated with the user”***, or a ***“means . . . for analyzing a coupon offer with respect to a plurality of user profile data records, and for generating one or more coupons based on said analysis”*** as set forth in claim 41, then anticipation under 35 USC 102(b) has not been established for at least these reasons.

Likewise, claim 69 is a method claim that has limitations similar to those in system claim 41 as discussed above. Thus, since the Tagawa reference does not teach ***“the coupon***

*server computer storing a plurality of user profile data records, each of said user profile data records comprising user profile data comprising: an identification of a user, and at least one an geographic location associated with the user,” or “analyzing a coupon offer with respect to a plurality of user profile data records”;* as set forth in claim 41, then anticipation under 35 USC 102(b) has not been established for at least these reasons.

B) Claims 41 and 69 are patentable at least because the value vouchers sold by the Tagawa kiosk are not coupons that provide “an incentive to purchase an item” that are distributed “for use by the user in purchasing the item associated with the coupon at the geographic location associated with the user”.

Tagawa teaches a self-service kiosk that displays offers to customers and allows them to *purchase* the related service using a credit card, and a “value voucher” is printed out for later use by the user. The value voucher acts as a receipt to confirm that *payment has been made*. Thus, Tagawa does not utilize coupons, stated in the claims as providing *an incentive to purchase an item*”, which are then distributed to a user for use in *purchasing the item associated with the coupon at the geographic location associated with the user*”. That is, even if the “offers” displayed at the kiosk screen were to be considered to be coupons, those “coupons” are merely displayed to the user while the user is standing at the kiosk to make a purchase selection at the kiosk itself. These “coupons” are never distributed to the user to enable him to purchase the associated item *at the location*. Thus, the offered displayed at the kiosk screen are not the claimed *coupons that provide “an incentive to purchase an item” that are distributed “for use by the user in purchasing the item associated with the coupon at the geographic location associated with the user.”*

Likewise, the value vouchers sold by the kiosk in Tagawa are evidence of a purchase *already made by the consumer* when he presented his credit card. These are not *coupons that provide “an incentive to purchase an item”* as claimed by the Applicant in the present application.

In order for a rejection to be properly made under 35 USC 102(b), it must be shown by the Examiner that *each and every claim limitation* is taught in a single reference. In re Spada, 911 F.2d 705 (Fed. Cir. 1990). Since the cited Tagawa reference does not teach the use of at least “*coupons that provide an incentive to purchase an item*” that are *distributed “for use by the user in purchasing the item associated with the coupon at the geographic location associated with the user”* as set forth in claims 41 and 69, then anticipation under 35 USC 102(b) has not been established for at least these reasons.

C) Claims 42-44, 47, 49-68 depend from claim 41 and are also patentable for at least the reasons specified above with respect to claim 41.

Dependent system claims 42-44, 47, 49-68 depend from independent claim 41 and are therefore patentable for at least the reasons specified above. That is, since the cited Tagawa reference does not teach the use of at least a “*means for storing a plurality of user profile data records, each of said user profile data records comprising user profile data comprising: an identification of a user, and at least one geographic location associated with the user*”, or a “*means . . . for analyzing a coupon offer with respect to a plurality of user profile data records, and for generating one or more coupons based on said analysis*” as set forth in dependent claims 42-44, 47, 49-68, then these claims are likewise patentable for at least these reasons. In addition, since the cited Tagawa reference does not teach the use of at least “*coupons that provide an incentive to purchase an item*” that are *distributed “for use by the user in purchasing the item associated with the coupon at the geographic location associated with the user”* as set forth in dependent claims 42-44, 47, 49-68, then these claims are likewise patentable for at least these reasons.

D) Claims 70-72, 75, 77-90 and 92-96 depend from claim 69 and are also patentable for at least the reasons specified above with respect to claim 69.

Dependent method claims 70-72, 75, 77-90 and 92-96 depend from claim 69 and are also patentable for at least the reasons specified above with respect to claim 69. That is, since the cited Tagawa reference does not teach the use of at least “*the coupon server computer storing a plurality of user profile data records, each of said user profile data*

*records comprising user profile data comprising: an identification of a user, and at least one an geographic location associated with the user,” or “analyzing a coupon offer with respect to a plurality of user profile data records”* as set forth in dependent claims 70-72, 75, and 77-96, then these claims are likewise patentable for at least these reasons. In addition, since the cited Tagawa reference does not teach the use of at least *“coupons that provide an incentive to purchase an item” that are distributed “for use by the user in purchasing the item associated with the coupon at the geographic location associated with the user”* as set forth in dependent claims 70-72, 75, 77-90 and 92-96, then these claims are likewise patentable for at least these reasons.

Therefore, it is respectfully submitted that the pending claims are patentable over the prior art of record. Applicant thus submits that the entire application is now in condition for allowance, early notice of which would be appreciated. Should the Examiner not agree with the Applicants' position, a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of this application.

Respectfully submitted,

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